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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/802,872 | 03/12/2001 | William Coan | 12177/44301 | 5649 |

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| EXAMINER | |
|---|---|
| ESCALANTE, OVIDIO | |
| **ART UNIT** | **PAPER NUMBER** |
| 2645 | |

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/802,872 | COAN ET AL. | |
| | Examiner | Art Unit | |
| | Ovidio Escalante | 2645 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *06 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-12,14-17,19-22,24 and 26-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12,14-17,19-22,24 and 26-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This action is in response to applicant's response filed on October 06, 2005. **Claims 1-12,14-17,19-22,24,26-28** are now pending in the present application.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-7,12,19-22,24, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouns in view of Mölne US Patent 5,943,611.

***Regarding claim 1***, Brouns teaches a method for providing enhanced features at a mobile communication device, (col. 2, lines 58-64), the device including a feature (full address book entries) having a set of sub-features, (partial address book entries), (abstract), comprising:

receiving, from a user at the mobile communication device, a request for one of the sub-features, (col. 3, lines 16-26);

searching the mobile communication device for the requested sub-feature, (col. 3, lines 16-41);

searching an enhanced local services server for the requested sub-feature, if the requested sub-feature is not resident of the mobile communication device, , (col. 3, lines 42-60);

accessing the requested sub-feature from the enhanced local services server, (col. 3, line 61-col. 4, line 3); and

receiving the requested sub-feature at the mobile communication devices via a wireless channel, (col. 3, line 61-col. 4, line 3).

While Brouns teaches of access the requested sub-feature, Brouns does not specifically teach of accessing the requested feature via a wireless digital control channel.

In the same field of endeavor, Mölne teaches of a directory assistance system in which the mobile communication device accesses via a digital control channel the requested feature, (col. 9, lines 43-62). Mölne states when the digital radiotelephone 16c is used for accessing the network directory database 22c, a digital control channel can be used to complete the data search without opening a voice channel.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brouns by using the digital control channel instead of opening a voice channel as taught by Mölne so that by using a digital control channel to transmit search criteria and results the air time required to transmit this information can be reduced, thereby reducing cellular access costs.

***Regarding claims 2,5 and 7***, Brouns in view of Mölne, in view of claims 1 and 4, teaches the requested sub-feature is received via the wireless digital control channel, (col. 9, lines 43-62, Mölne).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brouns by using the digital control channel instead of opening a voice channel as taught by Mölne so that by using a digital control channel to transmit search criteria and results the air time required to transmit this information can be reduced, thereby reducing cellular access costs.

***Regarding claim 3***, Brouns, teaches wherein said feature defines an address book service and wherein the set of sub-features defines a portion of a user-defined address book to be stored at the mobile communication device, (abstract).

***Regarding claim 4***, Brouns, as applied to claim 3, teaches wherein the received request comprises a request for access to a portion of said user defined address book which is stored in the wireless network, (abstract; col. 3, lines 42-60).

***Regarding claim 6***, Brouns, as applied to claim 4, teaches receiving an update transmission from said mobile communication device to effect a modification of said user defined address book stored in the wireless network, (col. 4, lines 23-40).

***Regarding claim 12***, Brouns teaches a method for provisioning services to a mobile communication device, (abstract), comprising:

programming the mobile communication device to provide a first set of features (partial address book entries) defining an aspect of a first service, (abstract);

programming a wireless network server to provide a second set of features, (col. 3, lines 16-26),

supplementing said first set, to fully define said first service, (abstract; col. 3, lines 42-60);

receiving, at the mobile communication device, a command to access said first service, (col. 3, lines 16-26);

responsive to said command, determining whether said first set of features can satisfy said command, (col. 3, lines 16-41); and

if it is determined that said first set of features cannot satisfy said command then automatically transmitting a request to satisfy said command to said wireless network server, (col. 3, lines 42-60).

While Brouns teaches of access the requested sub-feature, Brouns does not specifically teach of accessing the requested feature via a wireless digital control channel.

In the same field of endeavor, Mölne teachesw herein the request to satisfy said command is transmitted via a wireless digital control channel; (col. 9, lines 43-62). Mölne states when the digital radiotelephone 16c is used for accessing the network directory database 22c, a digital control channel can be used to complete the data search without opening a voice channel.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brouns by using the digital control channel instead of opening a voice channel as taught by Mölne so that by using a digital control channel to transmit search criteria and results the air time required to transmit this information can be reduced, thereby reducing cellular access costs.

***Regarding claims 19 and 27***, Brouns, as applied to claim 12, teaches wherein said first service comprises an address book, (col. 3, lines 16-26).

***Regarding claim 20***, Brouns, as applied to claim 19, teaches wherein said aspect of the first service comprises access to a first portion of said address book, (col. 3, lines 16-26; abstract).

***Regarding claim 21***, Brouns, as applied to claim 20, teaches wherein said command requests access to another portion of said address book, different from said first portion, (col. 3, lines 42-60).

***Regarding claim 22***, Brouns, as applied to claim 21, teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (col. 3, lines 61-col. 4, line 3).

***Regarding claim 24***, Brouns teaches a system for providing service features to a mobile communication subscriber, (abstract) comprising:

a mobile communication network, (fig. 2);

a mobile network services server coupled to said mobile communication network, (fig. 2); and

a mobile communication device coupled to said mobile communication network via an over-the-air transmission path, (fig. 2: TR-RS), said mobile communication device including,

a processor, (col. 3, lines 16-41); and

a memory (PTD) coupled to said processor and storing therein a program to perform the operations of, generating a command for a communication service based on a subscriber inputs, (abstract);

determining whether said communication service can be satisfied by the mobile communication device as a stand alone device, (col. 3, lines 16-41), and if it is determined that said mobile communication device cannot satisfy said communication service, then automatically transmitting a service request to said mobile network services server via said over-the-air transmission path, (col. 3, lines 42-60).

While Brouns teaches of access the requested sub-feature, Brouns does not specifically teach wherein said over-the-air transmission path comprises a wireless digital control channel

In the same field of endeavor, Mölne teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (col. 9, lines 43-62). Mölne states when the digital radiotelephone 16c is used for accessing the network directory database 22c, a digital control channel can be used to complete the data search without opening a voice channel.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brouns by using the digital control channel instead of opening a voice channel as taught by Mölne so that by using a digital control channel to transmit search criteria and results the air time required to transmit this information can be reduced, thereby reducing cellular access costs.

***Regarding claim 28***, Brouns, as applied to claim 24, teaches wherein said communication service relates to a personal information management service, (abstract; col. 3, line 42-60).

6. Claims 8-11,14-17 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brouns in view of Mölne and further in view of Kahan et al. US Patent Pub. 2002/0024536.

***Regarding claim 8***, while Brouns in view of Mölne, in view of claim 1, teaches of providing a plurality of features for the mobile communication device, Brouns does not specifically teach of defining a calendar service.

Kahan teaches that it was well known in the art to have a calendar service stored in the network and to send the calendar to the mobile device. Kahan also teaches wherein a feature defines a calendar service and wherein said set of sub-features defines a portion of a user defined calendar to be stored at the mobile communication device, (paragraphs 0006 and 0058).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brouns to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

***Regarding claims 9,11,14-16 and 26,***, Brouns as modified by Kahan in view of claims 8, 12 and 24, teach wherein said received request comprises a request for access to a portion of said user defined calendar which is stored in the wireless network, (paragraphs 0006 and 0058, Kahan);

receiving an update transmission from said mobile communication device to effect a modification of said user defined calendar stored in the wireless network, (paragraphs 0006 and 0058, Kahan);

wherein said first service/communication service comprises a calendar service having a plurality of scheduling options, (paragraphs 0006 and 0058);

wherein said aspect of the first service comprises a monthly scheduler capable of handling a subset of the scheduling options in the calendar service, (paragraphs 0006 and 0058); and

wherein said command requests to schedule an event outside of the scheduling options available with said aspect of the first service.

As stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Brouns to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

***Regarding claim 10***, Brouns in view of Mölne, as applied to claim 9, teaches wherein said wireless channel comprises a digital control channel, (col. 9, lines 43-62, Mölne).

As stated above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Brouns by using the digital control channel instead of opening a voice channel as taught by Mölne so that by using a digital control channel to transmit search criteria and results the air time required to transmit this information can be reduced, thereby reducing cellular access costs.

***Regarding claim 17***, Brouns, as applied to claim 16, teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (col. 3, lines 42-col. 4, line 3).

***Response to Arguments***

7. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

8. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(571) 273-7537, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is 571-272-7537. The examiner can normally be reached on M-Th from 6:30 to 4:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OVIDIO ESCALANTE
PATENT EXAMINER

Ovidio Escalante

Ovidio Escalante
Examiner
Group 2645
December 16, 2005

O.E./oe